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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,679	02/10/2004	Assaf Friedler	18396/2282	1897

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EXAMINER

ROOKE, AGNES BEATA

ART UNIT PAPER NUMBER

1656

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/775,679

Applicant(s)

FRIEDLER ET AL.

Examiner

Agnes B. Rooke

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 112(1), 112(2), 102(e) and 102(b).
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 24, 26, 29, 39, 44, 45 and 52.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 11. does NOT place the application in condition for allowance because: The Rejections to claims under 35 USC 112(1), 112(2), 102(e) and 102(b) are withdrawn in view of the amendments to the claims, since SEQ ID NO:1 in the instant invention is claimed as "isolated" and Naumovsky et al. in Figure 6 on page 3888, state that the SEQ ID NO:1 that is enclosed in Figure 6 is only a "predicted amino acid sequence" of SEQ ID NO:1.

Even though the rejections of claims under 35 USC 102(e) and 102(b) are withdrawn, a new rejection of claims 24, 26, 29, 39, 40, 44, 45, and 52, under 35 USC 103(a) will be applied since the instant invention is not patentable over the prior art because Naumovsky et al. teach:

- 1) SEQ ID NO:1 (REDEDEIEW) in Figure 6 on page 3888, which is the SH3 domain that binds to p53;
- 2) SEQ ID NO:1 has clear defined function as binding entity to p53;
- 3) the mutations claimed are well known in the prior art as pointed out by the Applicant on page 1, line 21-26, and page 2, line 1-8, of the specification;
- 4) the stabilizing molecule is a polypeptide, and thus it would contain an amine or amide as its intrinsic characteristic.

Therefore, it would have been obvious to design the SEQ ID NO:1 at the time the instant invention was made because Naumovsky et al. highlights SEQ ID NO:1 in Figure 6, and states that SEQ ID NO:1 is the SH3 domain necessary to bind to p53. One would be motivated to isolate the SEQ ID NO:1 because SEQ ID NO:1 as the SH3 domain is necessary for binding p53.

Applicants arguments refer to the assertions that:

- 1) Naumovsky et al. do not teach an isolated peptide of SEQ ID NO:1 but teach a polypeptide that may comprise SEQ ID NO:1 and that he does not teach an isolated SEQ ID NO:1. Examiner's response: withdrawal of 102(b) rejection.
- 2) Applicant states that SEQ ID NO:1 in Naumovsky et al. do not have a function. Examiner's response: the reference clearly discloses function of SEQ ID NO:1 as a binding entity to p53, see Figure 6.
- 3) Applicant states that the language of the claims states consisting of, where the Naumovsky et al. do not teach such a language. Examiner's response: withdrawal of 102(b) rejection.



KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER